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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/803,375	03/17/2004	Scott Lucas	CRM-3 CONT	5480
1473 7590 07/11/2008 ROPES & GRAY LLP PATENT DOCKETING 39/361 1211 AVENUE OF THE AMERICAS NEW YORK, NY 10036-8704				
EXAMINER				
BIBBEE, JARED M				
ART UNIT		PAPER NUMBER		
2161				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/803,375

**Applicant(s)**

LUCAS ET AL.

**Examiner**

JARED M. BIBBEE

**Art Unit**

2161

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 58-97 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 58-97 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SG/US)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Amendment***

1. This Office Action has been issued in response to amendment filed on 12 March 2008. Claims 1-57 are cancelled. Claims 58-97 are pending. Applicants' arguments have been carefully and respectfully considered in light of the instant amendment and are moot, as they relate to the claim rejections under 35 U.S.C. 102, due to a new grounds of rejection necessitated by Applicant's amendment as will be discussed below. Accordingly, this action has been made FINAL.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. **Claims 58-97 are rejected under 35 U.S.C. 102(e) as being anticipated by Nabe et al (US 2002/0194050 A1).**

With respect to independent claim 58, Nabe teaches a method for mapping one or more individuals associated with a user to an object associated with an external database (*see [0003]*; *Note that the offer/product is the object and it is coming from a dealer. The offer being a new*

*lease on a car or something similar. The dealer has a database full of cars/offers to lease.), the method comprising:*

- *storing in a profile database keyphrases that are associated with the one or more individuals associated with the user (see [0067]-[0069]; Note that the various customer characteristics (keyphrases) are used to help group customers in to categories to assist in targeting of offers/products.);*
- *providing the user access to the object associated with the external database, wherein the external database is different than the profile database (see [0071]; Note that the customers are given access through the web to various offers stored at the dealership database.);*
- *identifying one or more keyphrases in the object that match keyphrases stored in the profile database (see [0067]-[0069]; Note that the various customer characteristics (keyphrases) are used to help group customers in to categories to assist in targeting of offers/products. This suggests that customer characteristics are compared to offers to determine which offers are best suited for them. The grouping of customers suggests that more than one customer is associated with a given offer/product.);*
- *mapping the object to the one or more individuals associated with the user (see [0067]-[0069]; The grouping of customers suggests that more than one customer is associated with a given offer/product. In [0072], the lender customer database is combined with the dealer customer database to generate a list of contacts.); and*
- *displaying a list of individuals mapped to the object (see [0072]; Note the generated dealer customer contact list.).*

With respect to dependent claim 59, Nabe further teaches providing the user with an opportunity to transmit the object to one or more individuals from the list of individuals associated with the object (*see [0071]; Note that the customers are given access through the web to various offers stored at the dealership database. This suggests that the user is able to link an individual to an offer that best suits him/her.*).

With respect to dependent claim 60, Nabe further teaches storing the object in a memory (*see [0003] and [0072]; Note that the offer/product is the object and it is coming from a dealer. The offer being a new lease on a car or something similar. The dealer has a database full of cars/offers to lease.*); and interfacing the memory with a communication application when transmitting the object to the one or more individuals (*see [0071]; Note that the customers are given access through the web to various offers stored at the dealership database. This suggests that the user is able to link an individual to an offer that best suits him/her.*).

With respect to dependent claim 61, Nabe further teaches providing the user with an opportunity to add one or more keyphrases to one or more individual profiles in the profile database (*see [0031]*).

With respect to dependent claim 62, Nabe further teaches the object is an article (*see [0003]; Note that the offer/product is the object and it is coming from a dealer. The offer being a new lease on a car or something similar. The dealer has a database full of cars/offers to lease.*).

With respect to dependent claim 63, Nabe further teaches the object is a document (*see [0003]; Note that the offer/product is the object and it is coming from a dealer. The offer being*

*a new lease on a car or something similar. The dealer has a database full of cars/offers to lease. One of ordinary skill in the art would agree that a lease is a binding contract aka document.).*

With respect to independent claim 64, Nabe teaches a method for allowing a user to transmit an object associated with an external database to one or more individuals associated with the user (*see [0071]; Note that the customers are given access through the web to various offers stored at the dealership database. This suggests that the user is able to link an individual to an offer that best suits him/her.*), the method comprising:

- storing in a profile database keyphrases that are associated with the one or more individuals associated with the user (*see [0067]-[0069]; Note that the various customer characteristics (keyphrases) are used to help group customers in to categories to assist in targeting of offers/products.*);
- providing the user access to the object associated with the external database, wherein the external database is different than the profile database (*see [0071]; Note that the customers are given access through the web to various offers stored at the dealership database.*);
- identifying one or more keyphrases in the object that match keyphrases stored in the profile database (*see [0067]-[0069]; Note that the various customer characteristics (keyphrases) are used to help group customers in to categories to assist in targeting of offers/products. This suggests that customer characteristics are compared to offers to determine which offers are best suited for them. The grouping of customers suggests that more than one customer is associated with a given offer/product.*);

- mapping the object to the one or more individuals associated with the user (*see [0067]-[0069]; The grouping of customers suggests that more than one customer is associated with a given offer/product. In [0072], the lender customer database is combined with the dealer customer database to generate a list of contacts.*); and
- transmitting the object to the one or more individuals to which the object was mapped (*see [0071]; Note that the customers are given access through the web to various offers stored at the dealership database. This suggests that the user is able to link an individual to an offer that best suits him/her.*).

With respect to dependent claim 65, Nabe further teaches providing the user with an opportunity to add one or more keyphrases to one or more individual profiles in the profile database (*see [0031]*).

With respect to dependent claim 66, Nabe further teaches the object is an article (*see [0003]; Note that the offer/product is the object and it is coming from a dealer. The offer being a new lease on a car or something similar. The dealer has a database full of cars/offers to lease.*).

With respect to dependent claim 67, Nabe further teaches the object is a document (*see [0003]; Note that the offer/product is the object and it is coming from a dealer. The offer being a new lease on a car or something similar. The dealer has a database full of cars/offers to lease. One of ordinary skill in the art would agree that a lease is a binding contract aka document.*).

With respect to claims 68-77, note the discussion of claims 58-67 above, claims 68-77 are system claims corresponding to the method claims 58-67 and are rejected for the same reasons as set forth in the rejection of claims 58-67 above.

With respect to claims 78-87, note the discussion of claims 58-67 above, claims 78-87 are system comprising a software application implemented on a computing device (*see [0031]-[0033]*) claims corresponding to the method claims 58-67 and are rejected for the reasons set forth in the rejection of claims 58-67 above.

With respect to claims 88-97, note the discussion of claims 58-67 above, claims 88-97 are machine-readable medium (*see [0031]-[0033]*) claims corresponding to the method claims 58-67 and are rejected for the reasons set forth in the rejection of claims 58-67 above.

#### ***Response to Arguments***

4. Applicant's arguments with respect to claims 58-97 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.



Any inquiry concerning this communication or earlier communications from the examiner should be directed to JARED M. BIBBEE whose telephone number is (571)270-1054. The examiner can normally be reached on IFP.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Apu Mofiz can be reached on 571-272-4080. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. M. B./  
Examiner, Art Unit 2161

/Apu M Mofiz/  
Supervisory Patent Examiner, Art Unit 2161